

5. B. 300.5
12/30/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

AKERS, Douglas, W

Serial No. 09/932,531

Filing Date: August 17, 2001

For: METHOD AND APPARATUS FOR
PHOTON ACTIVATION POSITRON
ANNIHILATION ANALYSIS

Examiner: Palabrica, R.J.

Group Art Unit: 3641

Conf. No.: 4276

INTERVIEW SUMMARY UNDER 37 C.F.R. §1.133

To: The Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant notes with appreciation the telephonic interview courteously afforded the undersigned counsel on November 18, 2002, during which was discussed the appropriateness of the finality of the office action dated September 18, 2002. More specifically, the undersigned counsel requested that the examiner withdraw the finality of the office action in that the new grounds of rejection were not necessitated by the applicant's response to the first office action. MPEP Section 706.07(a) specifically provides that a second action should not be made final if it includes "a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed." In the September 18, 2002, office action, the examiner rejected claim 5 based in part on Strauss (U.S. Patent No. 3,803,416), a newly cited reference. Claim 5 (by virtue of its dependency from claim 1) was amended earlier to include subject matter similar (but not identical) to the subject matter contained in originally-filed claim 6. The undersigned counsel also requested the examiner to reset the response period pursuant to MPEP 710.06.

The undersigned counsel also requested the examiner to

reconsider his position with regard to the newly-submitted claims 20-36, and to examine those claims as being directed to the previously-elected Group I (i.e., apparatus) invention. Specifically, the undersigned counsel pointed out that new claims 20-36 differ only in scope compared with the originally-elected group I claims, thus are not properly restricted as being drawn to a non-elected invention.

Specifically, in the office action, paper no. 3, dated January 18, 2002, the examiner restricted prosecution to either the group I claims, drawn to "apparatus for non-destructive testing, classified in class 376, subclass 156" or to the group II claims, drawn to a "process of non-destructive testing using positron annihilation, classified in class 376, subclass 157." See the examiner's restriction required dated January 18, 2002. Applicant elected the group I claims, drawn to the apparatus. Newly-submitted claims 20-36 are directed to apparatus (not a process) for non-destructive testing. Therefore, new claims 20-36 fall within the previously-elected group I invention. The fact that new claims 20-36 differ in scope from the originally-filed group I claims is not a sufficient basis for regarding them as being drawn to a non-elected invention.

While no agreement was reached as to these two issues, the examiner agreed to look at the issues in more detail and respond with a decision by no later than Friday, November 22, 2002.

Official

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.

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